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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,302	03/27/2001	Donald T. Davis	2682.2016-001	9219

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EXAMINER

ALAM, UZMA

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,302

Applicant(s)

DAVIS ET AL.

Examiner

Uzma Alam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the amendment filed on December 7, 2004. Claims 1-35 are pending. Claims 1-35 represent a method for verifying the security of an applet connecting to a network server.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14, 16-31, and 33-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Touboul US Patent No. 6,092,194. Touboul discloses the invention as claimed including a system to protect a computer from suspicious Downloadables (see abstract).

As per claims 1, 16, 33, 34, and 35 Touboul discloses a method, a system, a computer data signal including a program code, a method from the client and a system with means of creating a network connection between an applet executing on a client computer and a content server computer, the method comprising:

determining a home site name for the applet, the home site name corresponding to a host name of a computer from which the applet was downloaded to the client computer (determining

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an ID including the original site of download; column 1, lines 36-57; column 2, lines 1-20; column 4, lines 41-45; column 5, lines 14-27);

checking for the presence of a hostname entry in a name directory on the content server computer, the hostname entry corresponding to the home site name for the applet (checking to see if ID is one of allowable IDs; column 6, lines 38-41)

permitting the applet to create a network connection with the content server computer if the hostname entry was present; and denying permission for the applet to create a network connection with the content server computer if the hostname entry was not present (allowing or denying connection based on ID; column 4, lines 41-61; column 5, lines 24-29; column 6, lines 41-51; column 7, lines 60-67; column 8, lines 1-6).

As per claims 2 and 17, Toubol discloses the method and system of claims 1 and 16, wherein checking for the presence of a hostname entry in a name directory on the content server computer comprises:

generating a Uniform Resource Locator for the hostname entry on the content server computer (generating a ID including a URL; column 4, lines 41-61); and

sending an HTTP request using the Uniform Resource Locator to the content server computer to determine whether the hostname entry is present in the name directory on the content server computer (sending the ID Toubol discloses to a Directory; column 4, lines 62-67; column 5, lines 1-15).

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As per claims 3 and 19, Toubol discloses the method and system of claims 2 and 17, wherein generating a Uniform Resource Locator comprises combining a host name of the content server computer, a path name of the name directory and a name of the hostname entry (URL includes userID, intended recipient; column 4, lines 41-61).

As per claims 4 and 18, Toubol discloses the method and system of claims 2 and 17, wherein sending an HTTP request using the Uniform Resource Locator comprises sending an HTTP HEAD-request using the Uniform Resource Locator to the content server computer to determine whether the hostname entry is present in the name directory on the content server computer (column 5, lines 17-29).

As per claims 5 and 20, Toubol discloses the method and system of claims 2 and 16, further comprising looking up an address of the content server (column 4, lines 41-43).

As per claims 6 and 21, Toubol discloses the method and system of claims 5 and 20, wherein checking for the presence of a hostname entry in a name directory on the content server computer comprises using the address of the content server to check for the presence of the hostname entry, and wherein permitting the applet to create a network connection with the content server computer if the hostname entry was present comprises using the address of the content server to create the network connection with the content server (the allowing or denying of the connection is based on the Downloadable ID; column 4, lines 41-43, 61-67; column 5, lines 16-29).

As per claim 7, Toubol discloses the method of claim 1, wherein an execution engine executes the applet on the client computer, and wherein checking for the presence of a hostname entry in a name directory of the content server computer comprises using network restriction software in the execution engine to check for the presence of the hostname entry (column 3, lines 41-67; column 4, lines 1-13).

As per claims 8 and 25, Toubol discloses the method and system of claims 1 and 16, wherein checking for the presence of a hostname entry in a name directory on the content server computer comprises using a consistent path name for the name directory (column 4, lines 14-29).

As per claims 9 and 26, Toubol discloses the method and system of claims 8 and 16, wherein checking for the presence of a hostname entry in a name directory on the content server computer comprises using an instruction from the applet on a path name for the name directory (column 4, lines 29-40; column 4, lines 49-61; column 5, lines 36-57).

As per claims 10 and 27, Toubol discloses the method and system of claims 9 and 26, wherein using an instruction from the applet on a path name for the name directory comprises using a language construct to determine the path name for the name directory (column 4, lines 29-40; column 4, lines 49-61).

As per claims 11 and 29, Toubol discloses the method and system of claims 1 and 16, further comprising using the hostname entry to determine types of network connections that are permitted between the applet and the content server computer (column 4, lines 62-67; column 5, lines 1-3).

As per claims 12 and 28, Toubol discloses the method and system of claims 1 and 16, wherein checking for the presence of a hostname entry in a name directory on the content server computer comprises checking for the presence of a file in the name directory that has a file name identical to the home site name for the applet (column 4, lines 49-61; column 6, lines 38-55).

As per claims 13 and 30, Toubol discloses the method and system of claims 1 and 16, the network restriction software further comprises the performing an address check (column 3, lines 49-61; column 5, lines 24-29).

As per claims 14 and 31, Toubol discloses the method of claim 13, wherein performing an address check comprises:

determining an address list for the content server computer (column 4, lines 14-26);

determining an address list for the computer from which the applet was downloaded (column 5, lines 16-29); and

denying permission for the applet to create a network connection with the content server

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computer if the address list for the content server computer is not a subset of the address list for the computer from which the applet was downloaded (column 4, lines 41-61; column 6, lines 41-51; column 7, lines 60-67; column 8, lines 1-10).

As per claim 22, Toubol discloses the client computer system of claim 16, wherein the name directory comprises a directory in a file system of the content server computer (column 3, lines 42-67; column 4, lines 1-14).

As per claim 23, Toubol discloses the client computer system of claim 22, wherein the hostname entry comprises an empty file in the name directory on the content server computer (column 3, lines 42-67; column 4, lines 1-14).

As per claim 25, Toubol discloses the client computer system of claim 16, wherein the name directory comprises a file on the content server computer (column 3, lines 42-67; column 4, lines 1-14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Toubol US Patent No. 6,092,194 in view of Donaldson US Patent No. 6,321,267. Donaldson discloses the invention substantially as claimed including a method for filtering.

Toubol discloses the method of claims and 30 13, wherein performing an address check comprises denying permission for the applet to create a network connection with the content server computer if the home site name for the applet is in a digital hash form, and an address specified by the digital hash form is not identical to an address for the content server computer (column 7, lines 46-59). Toubol does not expressly disclose "dotted quad". Donaldson discloses dotted quad. See column 17, lines 16-64; column 27, lines 63-67; column 28, lines 1-10. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the dotted quad of Donaldson with the digital hash of Toubol. A person of ordinary skill in the art would have been motivated to do this to simplify the address lists in the database.

Response to Arguments

Applicant's arguments filed December 7, 2002 have been fully considered but they are not persuasive.

As per the independent claims 1, 16 and 33-35, applicant argues that the downloadable does not execute during performance and therefore cannot make a network connection. In response to applicant's arguments, the recitation that the applet is not executing has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for

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completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The reference Toubol, however, does teach that the Downloadable, which includes applets, is an executable application program. Toubol also teaches that the applet is either permitted or denied connection with the content server based on the contents of the executable portion of the code. If the hostname is in the code, then the applet is permitted to run on the client. If the applet is requesting anything suspicious, the connection is blocked. See column 6, lines 49-60.

As per claims 2 and 17, applicant argues that Toubol does not disclose that the Downloadable ID includes the URL from which it came. In response, Toubol discloses the URL of the source of the Downloadable, which is where the Downloadable came from. See column 6, lines 38-45.

As per claims 3 and 19, applicant argues that Toubol does not teach a URL combining a host name of the content server computer, a path name of the name directory and name of the hostname entry. Toubol teaches checking what the applet what server the applet will connect to, which is the hostname of the content server. It is also well known in the art that a URL contains, according to its definition, a hostname, and a pathname. See column 5, lines 36-57.

As per claims 14 and 31, applicant argues that Toubol fails to discuss the subsets of he claims. Toubol also teaches that the applet is either permitted or denied connection with the content server based on the contents of the executable portion of the code. If the hostname is in the code, then the applet is permitted to run on the client. The source address and the address to

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which the applet is connecting to is all checked. See column 5, line s37-57; column 6, lines 38-60.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

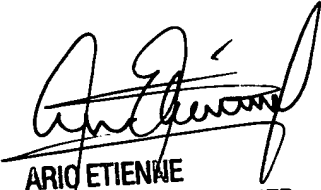
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uzma Alam whose telephone number is (571) 272-3995. The examiner can normally be reached on Monday-Tuesday 11:30am-8pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Uzma Alam
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